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Stephanie Seidman
FISH & RICHARDSON
12390 EL CAMINO REAL
SAN DIEGO CA 92130

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In re Application of :
NGUYEN et al :
Serial No.: 10/677,977 : Decision on Petition
Filed : October 2, 2003 :
Attorney Docket No.: 9061 :

This letter is in response to the Petition under 37 C.F.R. 1.144 filed on January 30, 2007 requesting reconsideration of the restriction requirement.

BACKGROUND

On November 2, 2004, the examiner mailed a first restriction requirement in which the original claims 1-44 were divided in 5 groups. The examiner further required an election of species to a number of mutations in the sequence, a protease scaffold sequence and a pathology.

On January 3, 2005, Applicants elected with traverse. The examiner found the traversal persuasive in part and then she examined Groups I and II together: claims 1-16 and 45-58 were searched and examined on the merits. The species examined was granzyme B protease scaffold and cancer as the pathology.

Applicants filed a response and added more claims.

On 11 April 2006, examiner sent out a second restriction requirement in which Claims 1-7, 9, 11-16, 45-48, 50-54, 56-66 were divided in 4 groups. The examiner again further required an election of species to a single species of a target and a single species of protease.

On September 11, 2006, applicants responded by electing Group IV, Claims 63-66, drawn to a method of identifying a human protease mutein employing the recited target and species of proteases recited therein. Applicant further elected the species of the target protein is caspases 3 and the species where the protease is granzyme B. The response traversed on the grounds that the methods contain related subject matter and each of Groups I-IV contain overlapping subject matter (see page 14 of the response filed September 11, 2006).

On November 30, 2006 the examiner mailed to applicants a second non-final Office action, this time, searching and examining Group IV (Claims 63-66) on the merits. The examiner incorrectly asserted that the election was made without traverse because applicant did not distinctly and specifically point out the errors in the restriction requirement. The examiner overlooked applicant's 6 pages of traversal.

On January 30, 2007, applicants filed this petition to request that the Office reconsider the restriction requirement.

DISCUSSION

The petition and file history have been carefully considered.

MPEP 803 states:

There are two criteria for a proper requirement for restriction between patentably distinct inventions:

- (A) The inventions must be independent (see MPEP § 802.01, § 806.06, § 808.01) or distinct as claimed (see MPEP § 806.05 - § 806.05(j)); and
- (B) There would be a serious burden on the examiner if restriction is not required (see MPEP § 803.02, § 808, and § 808.02).

MPEP 806 states in part:

The general principles relating to distinctness or independence may be summarized as follows:

.....

(C) Where inventions are related as disclosed but are not distinct as claimed, restriction is never proper.

....

Where restriction is required by the Office double patenting cannot be held, and thus, it is imperative the requirement should never be made where related inventions as claimed are not distinct. For (B) and (C) see MPEP § 806.05 - § 806.05(j) and § 809.03. See MPEP § 802.01 for criteria for patentably distinct inventions.

The petition filed January 30, 2007 clearly illustrates the overlapping steps and scope for each of the groups in the table presented on pages 3-6. The methods of Groups I-IV are not mutually exclusive and share overlapping subject matter. Moreover, the Office has already provided an examination of original Group I and II (in the first Office action) and Group IV (in the second Office action) for this single application, demonstrating that examination of Group I and IV, at least, did not impose a serious burden. Because the groups, as claimed, are not distinct and because the concurrent examination would not present a serious burden, requiring restriction between the claims is improper.

DECISION

The petition is **GRANTED** for the reasons set forth above. Claims 1-7, 9, 11-16, 45-48, 50-54, 56-62 are rejoined with the claims already under examination (Claims 63-66), and said claims will be examined together.

The requirement to elect a single protease (granzyme B) and a single target protein caspases 3 is maintained. Should the elected species become allowable, the claims will be examined according to election of species practice set forth in MPEP 803.02.

The application will be forwarded to the examiner for further action consistent with this decision and for the preparation of a new non-final action which addresses Group I, II, III and IV set forth in the restriction requirement mailed 11 April 2006.

Should there be any questions about this decision, please contact Special Program Examiner Julie Burke, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-1600 or by facsimile sent to the general Office facsimile number, 571-273-8300.



George Elliott
Director, Technology Center 1600
jb/jg